

II. Rejections under 35 U.S.C. §112, ¶2

Claims 19 and 27 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 19 and 27 have been canceled without prejudice or disclaimer. Thus, reconsideration and withdrawal of the rejection of these claims are respectfully requested.

III. Rejections under 35 U.S.C. §§102 and 103

Claims 1, 2, 5, 7, 8, 19, 21, and 27 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,992,940 to Dworkin. Claims 9, 10 and 29 have been rejected under 35 U.S.C. 102(b) as being anticipated over U.S. Patent No. 5,204,821 to Inui et al. Claims 3, 11-17 and 22-25 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,992,940 to Dworkin. Claims 20, 28 and 30-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,204,821 to Inui, et al. Claims 4 and 6 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,992,940 to Dworkin in view of U.S. Patent No. 5,204,821 to Inui et al. Applicants respectfully traverse the rejection of these claims as well as the Examiner's Official Notices.

Prior to discussing the claims, Applicants respectfully request the Examiner to cite a reference in support of each and every Official Notice taken in the Office Action dated June 7, 2000 and January 17, 2001 pursuant to MPEP §2144.03 (Reliance on Common Knowledge in the Art or "Well Known" Prior Art). The Official Notices were seasonably traversed in Applicants' prior response filed on November 7, 2000 (as acknowledged by the Examiner).

CLAIMS 1 AND 21

Independent claims 1 and 21 are directed to an arrangement in which a received order from one domain is expanded into its component parts and an order for each of the expanded component parts is communicated to another domain.

On the contrary, Dworkin simply provides an electronic shopping system in which a user may search for a product, view product specifications and, if desired, place an order for the product with a vendor. See Dworkin, Abstract, Figs. 2A and 2B, Col. 4, lines 3-Col. 9, lines 35. Once the user places an order for a product or service at terminal 5, the order is forwarded to the vendor 9a-d. The order placed by the user is not expanded into component parts with an order for each of the expanded component parts being communicated to another domain. Thus, Dworkin does not disclose or suggest the claimed combination of expanding a received order into its component parts or communicating an order for each of the expanded component parts to another domain. Since Dworkin does not disclose or suggest the above-noted limitations, the rejection is believed to be improper.

Furthermore, the Examiner's reasoning on page 25, Section 11(B) concerning "expansion means" does not address how Dworkin teaches each and every limitation in the claims, e.g., the claimed expansion. The Examiner simply states that "Applicant should appreciate that in order to construct any product for manufacture, the component parts that are required for that construction are necessarily needed [usually designated by a bill of materials], as well as an order in which to put the parts together [usually designated by an exploded parts diagram]." However, it is unclear what if any relevance the statement has in regards to the teachings of Dworkin. The subject matter of the Examiner's statement is not disclosed or

suggested by Dworkin. As discussed above, the Dworkin system merely provides a user with the ability to search for a product, view product specification and to order a product from a vendor.

Since claims 1 and 21 have been rejected as being anticipated by Dworkin, the Examiner is required to show how Dworkin teaches each and every limitation. As the Examiner's reasoning is not based on the teachings of Dworkin, the rejection of these claims under 35 U.S.C. §102 is further believed to be improper.

In view of the foregoing, claims 1 and 21 and the claims dependent therefrom are patentably distinguishable over Dworkin. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

Applicants respectfully request that the Examiner to identify with specificity where each and every limitation of the claims is taught by the Dworkin system.

CLAIMS 11, 12, 22 AND 23

Independent claims 11, 12, 22 and 23 are directed to an arrangement in which (1) a received order is expanded into its component parts and an order for each of the expanded component parts is communicated to another domain and (2) communication of an order to another domain is stopped in a case where an amount of specific parts contained in inventory is greater than a required amount of specific parts.

As discussed above for claims 1 and 21, Dworkin does not disclose or suggest expanding a received order into its component parts or communicating to another domain an order for each of the expanded component parts.

Furthermore, as acknowledged by the Examiner, Dworkin does not disclose or suggest the stopping of communication as noted above. However, the Examiner has taken

Official Notice that “it would have been logical to stop the order, in case the number of parts available in the inventory is more than the parts required to make/assemble a product.”

(emphasis added). Applicants respectfully submit that the taking of Official Notice by the Examiner is improper.

Official Notice may be taken as to facts outside of the record which are capable of instant and unquestionable demonstration as being “well-known” in the art. See MPEP §2144.03. However, in the present case, the Examiner is attempting to take Official Notice as to a conclusion or opinion (e.g., “it would have been logical . . .”) and not an undisputed fact. Accordingly, the Examiner’s Official Notice is believed to be improper.

Additionally, to establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. This requirement is a separate and distinct requirement from that of motivation to modify or combine. The Examiner has not provided any support in the prior art teaching or suggesting the claimed limitation: (2) communication of an order to another domain is stopped in a case where an amount of specific parts contained in inventory is greater than a required amount of specific parts. The Examiner simply states that “it would have been logical to stop the order, in case the number of parts available in the inventory is more than the parts required to make/assemble a product.”

In view of the foregoing, it is respectfully submitted that claims 11, 12, 22 and 23 and their dependent claims are patentably distinguishable over the cited references.

Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

CLAIMS 13 AND 16

Independent claims 13 and 16 are directed to an arrangement in which (1) a received order is expanded into its component parts and (2) permission to access ordering information is controlled through control means.

As discussed above for claims 1 and 21, Dworkin does not disclose or suggest expanding an order into its component parts.

Furthermore, as acknowledged by the Examiner, Dworkin does not disclose or suggest control of permission to access ordering information, but the Examiner believes and has taken Official Notice that “it would have been logical to have means for knowing order(s) received relative to a part by the vendor(s) and the fulfillment of the order/issuance of the ordered part.” (emphasis added). Applicants respectfully submit that the taking of Official Notice by the Examiner is improper.

Official Notice may be taken as to facts outside of the record which are capable of instant and unquestionable demonstration as being “well-known” in the art. See MPEP §2144.03. However, in the present case, the Examiner again is attempting to take Official Notice as to a conclusion or opinion (e.g., “it would have been logical . . .”) and not an undisputed fact. Accordingly, the Examiner’s Official Notice is believed to be improper.

Additionally, to establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. This requirement is a separate and distinct requirement from that of motivation to modify or combine. The Examiner has not provided any support in the prior art teaching or suggesting the claimed limitation: (2) permission to access ordering information is controlled through control means.

The Examiner simply states that “it would have been logical to have means for knowing order(s) received relative to a part by the vendor(s) and the fulfillment of the order/issuance of the ordered part.”

In addition, the Examiner has not provided any proper motivation for the modification. The Examiner simply indicates that it would have been logical to modify Dworkin to include claimed features, without providing any motivational basis why one would do so.

In view of the foregoing, it is respectfully submitted that claims 13 and 16 and their dependent claims are patentably distinguishable over the cited references. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

CLAIM 24

Independent claim 24 is directed to an arrangement in which (1) a received order is expanded into its component parts and an order for each of the expanded component parts is communicated to another domain and (2) information relating to a part delivery in accordance with an order is inputted in a database.

As discussed above for claims 1 and 21, Dworkin does not disclose or suggest expanding an order into its component parts or communicating to another domain an order for each of the expanded component parts.

Furthermore, Dworkin, as relied upon by the Examiner, does not disclose or suggest input of information relating to a part delivery. The portions of Dworkin relied upon by the Examiner simply show communication between a CPU 1 and a terminal 5. See e.g., Fig. 1 (1,5), Col. 4, lines 3-4, Office Action page 20. Dworkin is silent as to any input of information relating to “a part delivery” to a database in accordance with an order.

In addition, the Examiner makes statements in the Office Action that are not supported by any evidence in the prior art and, more specifically, are not taught by or related to Dworkin. For example, on page 18, the Examiner states “Parts management by manufacturing firm(s) is a dire need in order for continuous construction/manufacturing of products and provide the same to the customers on time.” Dworkin is simply silent as to parts management and construction/manufacturing of products. As discussed above, the Dworkin system merely provides a user with the ability to search for a product, view product specification and to order a product from a vendor.

In view of the foregoing, it is respectfully submitted that claim 24 and its dependent claims are patentably distinguishable over the cited references. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

CLAIMS 9 AND 29

Independent claims 9 and 29 are directed to a parts ordering system and a program, respectively, in which a machining plan is devised based on a received order, expansion is performed into each component part according to the machining plan, an order plan is devised for each expanded component part and order is placed according to the order plan.

On the contrary, Inui shows an order issue management system which is different than the above claimed arrangement. The order issue management system of Inui scans a parts master file to extract required data relating to parts to be ordered based on information fed to the system from a production schedule system, a parts information system and a car information system. Thereafter, the order issue managing system issues orders accordingly to a received

order managing system. Inui simply does not disclose or suggest the claimed combination of claims 9 and 29.

Moreover, the Examiner may not arbitrarily pick and choose elements from the Inui teaching, absent some suggestion in Inui. For example, the Examiner asserts that the claimed receiving of an order is taught by the received order managing system 21 of factory 20 (see Office Action page 7). However, the Examiner then asserts that the devising of a machining plan based upon the received order, the performing of expansion, etc. are taught by the subsystems of factory 10. As shown in Fig. 1 of Inui, the factory 20 with system 21 is downstream from factory 10. The Examiner's rejection is simply improper.

In view of the foregoing, it is respectfully submitted that claims 9 and 24 and their dependent claims are patentably distinguishable over the cited references. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

CLAIMS 20 AND 28

Independent claims 20 and 28 are directed to a parts ordering system and method in which information is communicated between a first and second network selectively depending on the importance of secrecy of the information. Communication of information is performed based on the importance of secrecy of the information.

As acknowledged by the Examiner, Inui does not disclose or suggest the above-noted arrangement, but the Examiner believes and has taken Official Notice that generally secrecy in information transfer is old and well known. However, the Examiner's Official Notice still does not address, teach or disclose communication of information between a first and second network being performed selectively based on the importance of secrecy of the information. The

Examiner may not ignore the specific claim language. Furthermore, the Examiner also has not provided any support in the prior art for such teaching.

Moreover, the Examiner has not provided any proper motivation in the prior art for modifying Inui in the suggested manner. For example, the Examiner states “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to include the feature of secrecy, because providing secrecy is an essential and integral requirement.” See Office Action, page 22 (emphasis added). This is simply a circular argument. The Examiner is asserting that one of ordinary skill would modify Inui with “secrecy” because it would be required.

In view of the foregoing, it is respectfully submitted that claims 20 and 28 and their dependent claims are patentably distinguishable over the cited references. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

CLAIMS 30, 33 AND 34

Independent claims 30, 33 and 34 are directed to a parts ordering system and method involving display of an icon for identifying receipt of an order or issuance of an order and data indicating results of receipt of an order or issuance of an order represented by the icon. Again, the Examiner has acknowledged that Inui does not disclose or suggest the above claimed display of the icon and data, but believes and has taken Official Notice that icons and their respective narrative representation(s) is old and well known technique in the computer art.

However, the Examiner's Official Notice still does not address the deficiency in the Inui teaching, namely display of information identifying receipt of an order or issuance of an order and data indicating results of receipt of an order or issuance of an order. The Examiner

merely points to a block diagram of an output interface 14g of Fig. 2 of Inui, but does not address or identify where the claimed display is taught in Inui.

Moreover, the Examiner has not provided any proper motivation in the prior art for modifying Inui in the suggested manner. For example, the Examiner states “[i]t would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to make use of the prevalent technique.” See Office Action, page 22 (emphasis added). However, as stated in MPEP §2143.01, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness, and the fact that references can be combined or modified is not sufficient to establish prima facie obviousness.

In view of the foregoing, it is respectfully submitted that claims 30, 33 and 34 and their dependent claims are patentably distinguishable over the cited references. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

In view of the foregoing, claims 1-17, 20-25 and 28-36 are patentably distinguishable over the cited references, individually or in combination. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-17, 20-25 and 28-36 and allowance of this application.

AUTHORIZATION

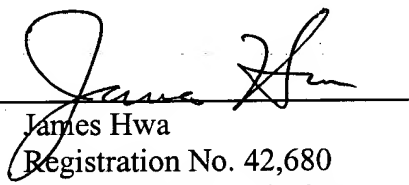
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4503, Order No. 1232-4457. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4503, Order No. 1232-4457. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,
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